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In the Supreme Court of the United States

OCTOBER TERM, 1947

No. ____

ALBERT R. MAULSBY,
Petitioner,

vs.

ABRAHAM CONZEVOY, doing business as Golden State Casket Co.,
Respondent.

Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit

To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Circuit Court of Appeals for the Ninth Circuit entered April 18, 1947 (R. Vol. V, 1391).

OPINIONS BELOW

The memorandum opinion of the trial court will be found at R. Vol. I, page 31. The opinion and dissenting opinion of the Circuit Court of Appeals will be found at R. Vol. V, page 1392. The same is reported at 161 F. (2d) 165.

JURISDICTION

The judgment of the Circuit Court of Appeals was entered April 18, 1947 (R. Vol. V, 1391). A petition for rehearing was seasonably filed and denied on June 2, 1947 (R. Vol. V, 1399). The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925. The suit arises under the patent laws for patent infringement.

STATEMENT OF THE MATTER INVOLVED

This is a patent infringement suit in which the patent has been held infringed if valid, but invalid.

Briefly stated the patent in suit relates to a method of attaching a backing fabric to a crushed silk facing in the preparation of a lining for use in burial caskets. Heretofore, this had generally been done by hand-sewed stitches between the backing fabric and puffs of the silk.

Others prior to the patentee had conceived of avoiding this laborious hand sewing by adhesively fastening the backing to the crushed silk. Experiments in this direction, however, had proved unsuccessful because:

(1) The adhesive would either soak through the silk and discolor it, or

(2) The adhesive on drying would objectionably stiffen either the silk or the backing fabric or both whereas the trade demanded that the lining produced be just as soft as a hand-sewed lining.

The patentee solved the problem of overcoming these objections by combining elements individually old in the art to secure the novel result of retaining the softness of both fabrics despite the inherent tendency of the adhesive to stiffen them on drying. In so doing he combined a fleecy backing such as flannel or domet with the "transfer method of pasting." In performing his method a thin film of adhesive was spread on a superficiary such as a glass plate. A fleecy backing such as domet was then positioned against the adhesive film with its fleece in engagement with the adhesive. The adhesive was then allowed to dry to the stage of becoming quite tacky, after which, the fleecy backing was pulled from the film drawing the hairs of the fleece out on end and drawing the adhesive out to the hair ends. Each hair, consequently, carried its own minutely small bit of adhesive by which it attached itself to the silk when the backing was positioned thereagainst. The amount of adhesive on each hair end was too small to soak through and discolor the silk and was incapable of stiffening either the silk or the fleecy backing fabric. The result was a lining made of two fabrics adhesively fastened together neither of which had been stiffened by the dried adhesive and which was acceptable to the industry as a labor saving substitute for hand-sewed linings.

The closest prior art was a so-called "smocking process" wherein unfleeced tapes had adhesive applied to them by the transfer method of pasting. These tapes due to the lack of fleece became quite stiff when adhesive applied to them was allowed to dry as is demonstrated by physical exhibits in evidence. See Defendant's St. Louis Exhibit 2 and Benzing Exhibits 3, 4 and 5 introduced in evidence (R. 495 and R. 1013). In places, the adhesive had also soaked thru the silk.

The Trial Court rendered a short memorandum opinion (R. 31) expressing his views in general terms and instructed defendant's counsel to prepare findings thereon. Pursuant to the direction made, defendant's counsel did prepare and submit findings (R. 32). The pertinent findings 4, 6, 7, 8, 9, 10 and 11 do little more than restate the memorandum opinion concluding that the patentee's method "does not constitute inventive genius but merely skill by one trained in the art."

On appeal the majority of the Circuit Court of Appeals in their opinion said (R. 1394, 1395):

> "Appellee alleged, in substance and effect, that the methods described in the claims were not new, and that therefore the claims were invalid for lack of novelty. The question thus presented was one of fact.
>
> "Appellee alleged, in substance and effect, that the methods described in the claims did not involve invention, but were merely the product of ordinary skill, and that therefore the claims were invalid for lack of invention. The question thus presented was one of fact.

"On both questions—the question of novelty and the question of invention—the evidence was conflicting. Resolving the conflicts in favor of appellee, the court found that the methods were not new, that they did not involve invention, and that therefore the claims were invalid for lack of novelty and for lack of invention. These findings are supported by substantial evidence, are not clearly erroneous and should not be disturbed." (Citing Rule 52A of the Federal Rules of Civil Procedure and *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 151 Fed. 2nd 91.)

The foregoing language is almost identical with the language used by the writer of the opinion in *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 151 Fed. 2nd 91, 94.

Insofar as the foregoing opinion is to the effect that the Trial Court resolved the question of novelty adverse to the patentee it is clearly erroneous. Evidence was submitted on behalf of the defendant by way of deposition that one Hall had performed the patentee's process late at night many years ago in a casket manufacturing plant in Chicago. This evidence was directly contradicted by the deposition of Ben Tarsitano and this conflict of evidence constituted the only conflict of evidence in the case. In the course of oral argument at the conclusion of the trial, the Trial Judge said in Volume II of the Reporter's Transcript of Testimony and Proceedings on Trial, page 73, line 23 et seq. (this volume has not been printed as it is entirely devoted to argument but has been transmitted as part of the record to this Court):

"THE COURT: *But there is no evidence in this case that anybody ever pasted a complete backing on a crinkled material, either fleeced material or muslin that is so far as the prior art is concerned.* I am assuming that to be a fact because the only testimony to the contrary is that of Hall. I think there is a heavy burden placed on the defendant in this respect. I don't believe they have overcome this burden by reason of his having done this at night he has no corroboration. But there is a step forward you have made, the labor saving feature of pasting instead of sewing."

Consequently, contrary to the statement made by the majority of the judges of the Circuit Court of Appeals the Trial Court did not resolve the question of novelty in favor of the defendant or find that the method was not new. On the contrary, the Trial Court by rejecting the uncorroborated testimony of Hall resolved the question of novelty in favor of the patentee. Dissenting Judge Stephens has specifically dissented from the holding of the majority on the question of novelty.

On the question of invention there is no conflict of evidence as stated by the majority opinion. There is no direct testimony by any witness as to whether or not the improvement made by the patentee constituted invention or mere mechanical skill. There is no dispute as to the practices in the prior art. There are many physical exhibits in evidence with relation to these prior art practices and there are physical exhibits in evidence of the results obtained by the use of the patentee's process. No expert testimony has been offered to evaluate the disclosures or practices of

the prior art and the invention disclosed. In fact, the patent in suit is so simple that the Trial Court rejected a courtroom demonstration of it (R. 86, 87). Inasmuch as the Trial Court determined that the patentee's process was new and there is no dispute with relation to the facts of the prior art or the improvement that the patentee has made, the question of invention can be determined from a mere comparison of the physical exhibits.

Even if the evidence on the question of invention had been conflicting—and we cannot over-emphasize that it is not—seven-eighths of the testimony taken in this case is by way of deposition. With respect to the evidence thus submitted by way of deposition, the trial judge had no advantage over the judges of the Circuit Court of Appeals and the majority consequently should have given little, if any, weight to the findings of the Trial Court.

The dissenting judge (R. 1397) dissented from the decision that the patent claims were invalid for want of novelty and, while acknowledging the above-mentioned conflict in the testimony with relation to Hall's alleged anticipatory practice, concluded that there was no substantial conflict as to the basis of the claims and the result obtained. He, consequently, proceeded to consider the question of invention unhampered by the finding of the Trial Court and concluded that "there was genuine discovery or invention in the method described."

The fundamental difference between the opinion of the dissenting judge and the judges of the majority concerns the weight to be given to the finding of the Trial Court on the question of invention when there is no substantial dis-

pute as to the facts of the prior art and the improvement that the patentee has made with relation to them. Apparently, the majority regard Rule 52A of the Rules of Civil Procedure as mandatory and controlling regardless of the lack of dispute with respect to prior art facts and regardless of the fact that seven-eighths of the testimony is by deposition. The dissenting judge was of the opinion that the question of invention under these circumstances is open to review.

If the majority is correct, the result that necessarily follows is that in patent cases the District Judge becomes the final arbiter on the question of whether the improvement over the prior art shall be designated a patentable invention or merely unpatentable mechanical skill. The question of invention over undisputed prior art is necessarily a matter of opinion—frequently guided by established precedents. R. S. 4886 lays down no rules by which the question of invention can be determined and even this Court has had difficulty in laying down any universal rule or test by which invention can be determined. Certainly it was not the intention in formulating Rule 52A of the Federal Rules of Civil Procedure to confer such authority on District Judges in patent litigation by making their findings on the question of invention unassailable unless "clearly erroneous." Particularly is this true where, as here, those findings that were made by the District Judge deal only with the vaguest conclusions of ultimate fact-ignoring entirely, and making no finding upon evidence dealing directly with tests of invention as laid down by this Court.

QUESTIONS PRESENTED

1. Has the Trial Court herein complied with Rule 52A of the Rules of Civil Procedure requiring him to "find the facts specially" when those findings that are made in his memorandum opinion and which are restated in the findings of fact and conclusions of law prepared by defense counsel are but vague and indefinite conclusions of ultimate fact?

2. Where the Trial Court makes no circumstantial findings of fact but merely concludes as a general conclusion that no invention is involved in the disclosure of the patent in suit, is the Appellate Court justified in confining its review to a determination of whether or not the question of invention is a question of fact and applying Rule 52A thereto when the question of invention is held to be one of fact?

3. Where with all the evidence before the Appellate Court it appears that there is no substantial dispute of fact and the case may be determined by a mere comparison of structures exemplified by physical exhibits and no extrinsic evidence is needed for purposes of explanation or evaluation of prior art, is the question of invention to be treated by the Appellate Court on appeal as a finding of fact under Rule 52A that is assailable only if "clearly erroneous" or is it to be treated and reviewed by the Appellate Court as a question of law?

4. Where a large fraction of the testimony is by deposition and virtually all of the evidence pertaining to prior

art practices is by deposition, is the Trial Court's finding of lack of invention entitled to any great weight under Rule 52A on appeal?

REASONS FOR GRANTING THE WRIT

1. The Trial Court by entering vague and indefinite findings amounting to little more than the most general conclusions of ultimate fact has acted inconsistently with the decision of this Court in *Schneiderman v. U. S.*, 320 U.S. 118, 192, 139, 131 wherein this Court speaking through Mr. Justice Murphy indicated under similar circumstances that "we would be inclined to reverse and remand to the District Court for the purpose of making adequate findings"

2. Where the Trial Court enters vague and indefinite findings and concludes that no invention is involved in the patent in suit after disregarding evidence pertinent to the question of invention, the manner in which the Circuit Court of Appeals is to review the case is an important matter of procedure under the Federal Rules of Civil Procedure which should be clarified and settled by this Court.

3. Where there is no dispute as to the prior art facts and the question resolves itself into a question of whether the improvement made shall be designated a patentable invention or mere unpatentable mechanical skill this Court should settle the uncertainty as to whether such a question is a question of law or a question of fact. This Court has said that where the question is whether the thing patented amounts to a patentable invention or not,

is a question of law in *Mahn v. Harwood*, 112 U.S. 354, 358, and dissenting judges of this Court have cited that case to this effect and in *Goodyear v. Ray-O-Vac*, 321 U.S. 275. In somewhat similar vein, this Court has stated in *U. S. v. Esnault-Pelterie*, 303 U.S. 26, 30, that where there is no substantial dispute of fact and the case can be determined by a mere comparison of structures and extrinsic evidence is not needed "the question of invention and infringement may be determined as questions of law."

On the other hand, this Court has said in *Thompson Spot Welder Co. v. Ford Motor Co.*, 265 U.S. 445, 447, "The question whether an improvement requires mere mechanical skill or the exercise of faculty of invention is one of fact; and in an action of law for an infringement is to be left to the determination of the jury."

With this lack of harmony in the decisions of this Court, Circuit Courts of Appeal have indicated a desire for enlightenment on how a finding on the question of invention by the Trial Court is to be treated on appeal due regard being had to Rule 52A. See *Lincoln Stores v. Nashua Manufacturing Co.*, 157 Fed. 2nd 154, 163 (C.C.A.1); *White v. Bruce*, 73 U.S.P.Q. 420, 421; *Hanovia Chemical and Manufacturing Co. v. Buttrick*, 127 Fed. 2nd 888, 890 (C.C.A.1), and *Cusano v. Cotler*, 72 U.S.P.Q. 62, 63 (C.C.A.3). This uncertainty as to whether or not the question of invention is a question of fact or a question of law and, if a question of fact, how it is to be treated by the Appellate Court on appeal particularly when the prior art is undisputed and

is clearly understandable should be definitely settled by this Court. It is a question which arises in most patent appeals and a definite course of procedure with relation thereto should be established.

4. The Circuit Court of Appeals herein has acted inconsistently with decisions of this Court and decisions of other Circuit Courts of Appeal notably *U. S. v. Esnault-Pelterie,* 303 U.S. 26, 30, *Hanovia Chemical and Manufacturing Co. v. Buttrick,* 127 Fed. 2nd 888-890; *Sbicca-Del-Mac Inc. v. Milius Shoe Co.,* 145 Fed. 2nd 389 (C.C.A.8); *Tyree Chemist Inc. v. Thymo Borin Laboratory,* 151 Fed. 2nd 621 (C.C.A.7), and *Butex Gas Co. v. Southern Steel Co.,* 123 Fed. 2nd 954 (C.C.A.5), as to whether Rule 52A operates to entrench with finality the ultimate fact conclusions with relation to the question of invention drawn by the Trial Court.

5. As seven-eighths of the testimony record in this case is made up of depositions, the majority of the judges of the Circuit Court of Appeals herein are acting inconsistently with other judges of the same Court in *Equitable Life v. Irelan,* 123 Fed. 2nd 462, and the many cases collected and cited therein in the footnote which are to the effect that where the evidence to support a finding is by deposition "the reviewing Court gives slight weight to the findings" of the Trial Court based thereon.

6. This Court should discourage a mere perfunctory approval by Appellate Court judges of a finding of non-invention by the Trial Court particularly when such a finding is not supported by any circumstantial findings and

where important findings have been omitted concerning evidence dealing with established tests of invention.

7. As the Casket Manufacturers Association formed a defense committee for the purpose of defeating the patent in suit and solicited financial and other contributions to the defense from substantially the entire unlicensed portion of the industry, (R. 1132-1140) appointed defense counsel and in general assumed the defense of this case there is wide interest in the casket industry as to whether the patent in suit is valid.

8. Due to the fact that the patent has only two years to run and a large portion of the casket industry by contributing and participating in the defense are consequently probably in a position to assert a defense of *res adjudicata* it is extremely doubtful whether it will be possible for the plaintiff to locate an infringer who is not so protected and institute a suit in another circuit for the purpose of securing a diversity of opinion on the question of invention before the patent expires.

9. The conclusion of the District Court of no invention is "clearly erroneous" under established tests of invention as laid down by this Court. While the majority of this Court has said in *Goodyear v. Ray-O-Vac, supra,* "it must be a strong case in which this Court will set aside the concurrent findings of two Courts," Mr. Justice Taft in *Eibel v. Minnesota,* 261 U.S. 45, said, "A case that can be made out in all its elements by cross-examination of opposing witnesses *is a strong case*" and that is the situation here. Defendant's witnesses have testified herein to ex-

periments made to solve the identical problem solved by the patentee herein and to their failure and have acknowledged that their manufacturing concerns subsequently took licenses under the patent in suit.

CONCLUSION

For the foregoing reasons it is respectfully submitted that this petition should be granted.

FRED H. MILLER.

CERTIFICATE OF COUNSEL

I hereby certify that in my opinion the foregoing Petition is well founded and is not interposed for delay.

FRED H. MILLER.

In the Supreme Court of the United States

October Term, 1947

No. _____

ALBERT R. MAULSBY,
Petitioner,

vs.

ABRAHAM CONZEVOY, doing business as Golden State Casket Co.,
Respondent.

Brief for Petitioner in Support of Petition for Writ of Certiorari

THE OPINIONS OF THE COURTS BELOW

The opinion of the Circuit Court of Appeals for the Ninth Circuit is reported at 161 Fed. 2d, 165. This opinion consists of the opinion of the majority and the dissenting opinion of Judge Stephens. The opinions appear in the Record at pages 1392 to 1397. The Memorandum Opinion of the District Judge is unreported but appears at Rec. 31. The Findings of Fact and Conclusions of Law appear in the Record at pages 32-34.

JURISDICTION

The judgment of the Circuit Court of Appeals was entered April 18, 1947 (R. 1391). A petition for rehearing was seasonably filed and denied June 2, 1947 (R. 1399). Jurisdiction of this Court is invoked under Section 240a of the Judicial Code as amended by the Act of February 13, 1925. The action is brought under the patent laws for patent infringement.

STATEMENT

In order to fully appreciate the inadequacy of the findings of the Trial Court under Rule 52A of the Rules of Civil Procedure and the resulting effect when the Circuit Court of Appeals confines its review to merely a determination that the conclusion of noninvention is a question of fact and that Rule 52A is applicable, a clear understanding of the invention of the patent in suit and of salient portions of the Record is believed necessary.

The plaintiff's patent relates to a method of applying backing fabrics to crushed silk and satin linings such as are employed in lining burial caskets. Prior to the development of the invention of this patent the common practice was to prepare such linings by placing a piece of silk or satin on a crushing machine which, when operated, would crush or crinkle the silk, forming it into puffs of various shapes and designs. An early machine for performing this crinkling or crushing operation was placed on the market as early as 1908 (R. 81) and was known as the Milwaukee

Crushing Machine. Other crushing machines for accomplishing generally the same purpose were subsequently placed on the market and were known as the Spokane machine, the Sliter machine, and the Maulsby machine (R. 82, 83). In the use of such machines a section of silk or satin was placed thereon in inverted or upside down position so that its reverse side was disposed uppermost. After the silk or satin had been crinkled or crushed it was held in its crushed position by attaching thereto a backing fabric. This backing fabric was universally sewed to the silk by taking one or more hand stitches through the backing fabric and through each individual puff of the silk. As stated in the patent book of exhibits, page 1083, lines 17 et seq.:

> "It is a very painstaking, tedious and expensive operation to sew the backing fabrics to the crushed silk lining. In fact, this work is generally done by hand and is one of the most expensive items in the manufacture of caskets since it is required that each fold or puff of the crushed silk be attached by a fine thread or stitch so applied as not to be noticeable."

The patentee proposed attaching the backing to the crushed silk by means of an adhesive in lieu of this hand sewing. This thought had probably occurred to many. However, the mere substitution of a gluing or pasting operation for the hand stitching would not satisfactorily solve this problem for, as stated in the patent exhibit book, page 1083, lines 27 et seq.:

> "Heretofore many attempts have been made to devise a method whereby the crushed silk could be

attached to the backing by use of an adhesive, but prior to the present invention these attempts have been unsuccessful or at least very unsatisfactory for the reason that it was impossible to apply the glue or adhesive *in such a manner that it would not show through the thin silk or cause stiffness to the fabric.* There was difficulty in spreading the glue and if it was applied to the backing in sufficient quantity to hold the silk it would penetrate through and spot the surface. It is essential when an adhesive is used that it be so distributed and so thinly applied that it will not be absorbed by the silk but will dry without penetration, and *it is also essential that it shall not cause stiffness or give any impression of stiffness to the finished article.*"

According to the invention of the patent in suit, the adhesive is spread in a thin film over a surface such as a glass plate and a backing fabric having a nap or fleece such as flannel or domet is applied to the surface with the fleece side of the fabric against the adhesive. The adhesive is then allowed to dry to the extent of becoming quite tacky and the backing fabric is then pulled from the surface, raising the nap, i. e., drawing the hairs of the fleece out on end and drawing the adhesive thereon out to the ends of the fleece. Each hair of the fleece consequently carried its own minute bit of adhesive by which it attached itself to the crushed silk. The result is that these microscopically small bits of adhesive were too small to penetrate through the silk to spot it and, although the adhesive, on drying, became hard and stiff, the small bits

of adhesive on the hairs ends were incapable either individually or collectively of stiffening either the backing fabric or the silk.

The procedure of spreading the adhesive on a surface and then applying the article to be glued to the adhesive thus spread, subsequently removing it and applying the article with its attached adhesive to the article to which it was to be glued, is known in the art as the "transfer method of pasting." It is admitted by the plaintiff to be old in his own deposition (R. 439). This procedure, however, is but one element of the plaintiff's combination. The invention resides in combining with the transfer method of pasting the use of a fleecy backing and allowing the adhesive to dry to a tacky stage before pulling the backing from the adhesively coated surface to thus draw the hairs of the fleece out on end and draw the adhesive out to the hair ends. In this manner the adhesive is prevented from soaking into either the silk or the warp and yarn of the flannel so that neither fabric is stiffened by the adhesive on drying. This is the new result resulting from the combination of using a fleecy backing with the transfer method of pasting, namely the retention of softness of both fabrics despite the inherent tendency of the dried adhesive to stiffen them.

If the combination is altered the result of retained softness is not obtained. Thus, if a fleecy backing is used in combination with the brush-on method of pasting, the result is a stiffened lining as is proved by Plaintiff's Physical Exhibit 3, introduced in evidence at Rec. page 88. Conversely, if an unfleeced backing fabric is used in com-

bination with the transfer method of pasting, similar stiffness results as is proved by Plaintiff's Exhibit 5, introduced at Rec. page 89. It is only when the proper combination is used, namely, a fleecy backing in combination with the transfer method of pasting that the result of retained softness is obtained. This is proved by Plaintiff's Exhibit 6, introduced in evidence at Rec. p. 90 (and erroneously referred to by the Clerk at this page as Plaintiff's Exhibit 7).

In the casket making industry it is of importance that the lining be soft. Z. R. Maulsby explains this as follows (R. 207):

> "Q. What difference does it make, Mr. Maulsby, if the work is stiff?
>
> "A. Well, we always considered that our sales depended on the eye appeal as well as the sense of touch. Families go into funeral directors' display rooms and they invariably put their hands on the silk work, and if it is stiff and harsh to the touch, they just don't want to buy that. They will buy another casket that is soft and well-made, and reflects the quality.
>
> When they do that, we get to sell a replacement, whereas, if we had a stiff, unyielding backing behind our silk work, chances are people would not be so apt to buy it."

A lining for a casket that is stiff and hard is unsuitable, as testified to by Dent Maulsby (R. 147):

> "Q. I will hand you Plaintiff's Exhibit No. 3, and call your attention to the stiffness of the backing.

Would that type of a lining be suitable for use in a casket such as you manufacture?

"A. It would not.

"Q. What would be the objection to it?

"A. Well, it is too stiff; feels too hard.

"Q. Could you sell that in competition, to an undertaker who, for instance, had available to him caskets with a lining like in Exhibit 6?

"A. I don't believe you could sell this article. You might sell it once.

"Q. That is Exhibit 3?

"A. Yes, Exhibit 3, I don't believe you could continue in business, using lining of this type.

"Q. How about Exhibit 4?

"A. This is worse yet.

"Q. How about Exhibit 5?

"A. This also would be unacceptable."

During the trial, the following transpired (R. 67):

"Q. Why is it desirable to have these linings so soft, do you know?

"THE COURT: I think the parties will all admit that it is desirable in the trade that the lining be soft, would it not? Isn't that so?

"MR. BOYKEN (representing the defense): There is no dispute about that."

Defense witnesses have testified herein that experiments to develop a pasting process for attaching the backing to the lining were rejected because the result was not soft enough. Thus defendant's witness Ellerbrock testified at Rec. 545:

"DQ. 18. What sort of process was used with these Milwaukee boards and Sliter boards?

"A. Principally sewing, although sometime between 1928 or '29 we had a foreman in our cloth department, a Mr. Louis Neiner, who has been deceased since 1941, he always thought it was possible to do a gluing operation on these boards instead of sewing. The result of his experiment was a *rather hard background that didn't make the decorations soft enough, and from that standpoint we did not adopt it.*"

The same defendant's witness testified at Rec. 598:

"CQ. 250. Now, if I get the events correctly you had a Milwaukee Crushing Machine purchased before 1920, you duplicated the Milwaukee Crushing Machine in 1925 so as to have a larger machine like the Milwaukee Crushing Machine, and then bought the Sliter machine in April, 1928, is that correct?

"A. That is correct.

"CQ. 251. And according to your testimony here you attempted to do some gluing with these machines somewhere around the latter part of the '20's by gluing the backing to the linings, is that correct?

"A. That is correct.

"CQ. 252. You were not successful in doing that, were you?

"A. *We were successful in gluing but it did not produce the softness of the finished product to our satisfaction.*"

Ellerbrock is corroborated by another defendant's witness Wolf at Rec. 651, although Wolf places the date of Neiner's experiments at being in 1920.

Others besides Neiner had likewise endeavored to develop an acceptable substitute for hand sewing by using an adhesive. Thus, Z. R. Maulsby testified to his experiments and their failure at Rec. 200.

When the plaintiff's process was developed it was submitted to the trade. Defendant's witness Ellerbrock testifies at Rec. 582 concerning his reaction to the patentee's method:

> "A. Because in experimentation here we had been trying to glue backing material on this Sliter board *which we didn't consider soft enough for our purpose* and was never commercially used. *We thought Mr. Maulsby had something better is the reason we gave him an opportunity to demonstrate his plan.*"

Ellerbrock's concern, the Kregel Casket Company, subsequently took a license to use the process of the patent in suit. The trade generally was approached by the patentee both before and after the patent issued. Printed contracts were prepared and submitted. That form of contract submitted before the patent issued is reproduced at page 1089 of the Record and the concerns listed at R. 1090 are the names of the concerns who entered into a contract of that character. After the patent issued, contracts of the type appearing at page 1091 of the Record were submitted, and the names and dates of the licensees who entered into a contract of this type are listed at pages 1092 to 1094 of the record.

With this understanding of the facts of the case in mind, we now call attention to the manner in which the

case was disposed of by the Trial Court. In the Memorandum Opinion (R. 31) the District Judge states in Paragraph A that the patent in suit, in its final analysis, is nothing more nor less than the substitution of gluing or pasting for sewing—that this substitution is not new in the art and that he feels that the use of glue for fastening materials together is old in all arts. These observations are not very helpful for if a mere substitution of gluing or pasting for sewing was sufficient, Neiner's experiments would never have been rejected as failures, nor would the experiment of Z. R. Maulsby. Likewise, the large number of licensees who quickly took licenses, above referred to, would never have obligated themselves to pay the amounts specified in the respective licenses in exchange for merely being told that pasting or gluing could be satisfactorily substituted for sewing.

The District Judge further states that the substitution produced no new result and refers to a "general rule" that cannot be identified. The result obtained herein is new in respect to the retention of softness by the fabrics whereas with any other pasting or gluing method, either or both of the fabrics would be stiffened by the dried adhesive as is proved by Physical Exhibits 3 and 5 above referred to.

In Paragraph B of the Memorandum Opinion the Court refers to the steps as being old and repeats the statement that there is no new result. The *modus operandi* of the transfer method of pasting is concededly old but this method of pasting has never been combined with a fleecy backing and in so doing, delaying the removal of the back-

ing until the adhesive was tacky enough to draw the fleece out on end to obtain the new result of avoiding stiffness. Reference is made in this paragraph to a "general rule" and to a "broader rule" neither of which can be identified. The Court further finds in this paragraph that the patent in suit is not a combination patent but an aggregation, whereas, as is proved by the physical exhibits 3, 5 and 6, the presence of each element, namely, the fleecy backing and the transfer method of pasting is necessary. Each modifies or affects the other, whereas this is not the result when the combination is altered, as is proved by Plaintiff's Physical Exhibits 3 and 5. (Introduced at R. 88 and 89 respectively).

Finally the Court concludes in Paragraph C of the Memorandum Opinion that the step taken does not constitute inventive genius but merely skill by one trained in the art. Such a holding is directly opposed to Ellerbrock's testimony, the testimony of a defendant's witness to the effect that Neiner experimented; that he did not develop the process of the patent, and that his experiments were rejected as failures (R. 545).

No finding is made by the Trial Court to the effect that Neiner and others experimented in this direction and failed. No finding is made concerning the commercial success of this method as is proved by the license agreements quickly entered into (R. 1089 to 1094). Under the terms of Rule 52A:

> "Requests for findings are not necessary for purposes of review."

The majority of the Circuit Court of Appeals have confined themselves to a consideration of whether the Trial Court has made a finding on the question of invention—whether such a finding is on a question of fact and whether Rule 52A is applicable thereto to the effect that such a finding cannot be disturbed unless "clearly erroneous."

ASSIGNMENTS OF ERROR

1. The District Court erred in failing to find the facts specially as required by Rule 52A of the Federal Rules of Civil Procedure and instead in entering findings in the form of vague and indefinite conclusions.

2. The majority of the Circuit Court of Appeals erred in confining its attention to a question of whether or not the lower court's conclusion of no invention is a question of fact and whether under Rule 52A such a finding "shall not be set aside unless clearly erroneous."

3. The District Court erred in failing to find in accordance with the testimony of defendant's witnesses that persons skilled in the art had attempted to develop patentee's process, had failed in their experiments and that, therefore, the solution of the patentee's problem was not obvious to persons skilled in the art.

4. The District Court erred in failing to find that when the patentee's process was disclosed to the trade it was immediately accepted by a large number of licensees as satisfying a long-felt want in the industry and that, therefore, the patentee's process constituted an innovation in the art.

5. As there is no conflict in the evidence and physical exhibits in evidence prove that a new result of retained softness in the fabrics is obtained; defendant's witnesses have testified that others had experimented and had failed; and written documents established that the industry quickly adopted the process when it was disclosed to it, the Circuit Court of Appeals erred in failing to examine into this undisputed evidence and arrive at its own independent conclusion of whether or not a patentable invention had been made instead of applying the finding of fact rule embodied in Rule 52A.

6. The District Court and the Circuit Court of Appeals erred in failing to conclude from the undisputed evidence that the plaintiff's patent is valid and has been infringed.

ARGUMENT

The Patent in Suit Complies With Recognized Tests of Invention as Laid Down by This Court

A. A Combination of Old Elements Producing a New Result Is Generally Regarded as Patentable

This Court has said in *Webster Loom Co. v. Higgins*, 105 U.S. 580, 591:

> "It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produces a new and beneficial result never attained before, it is evidence of invention."

The new result obtained by the patentee's process of using a fleecy backing fabric in combination with the

transfer method of pasting is that neither fabric will be stiffened by the adhesive on drying. It is true that fleecy backing fabrics are old in the art. It is also true that the transfer method of pasting is old but they have never been combined before to secure this new result of retained softness.

In Finding 8 (Rec. 33) the Trial Court found that no new and patentable result was obtained by the patentee's process. However, it is impossible to determine either from the finding or from the Memorandum Opinion (Rec. 31) what result the Trial Court had in mind. If the result that the Trial Court had in mind was that the completed lining merely consisted of the crushed silk and the backing fabric *attached* together, the result was, of course, old inasmuch as these fabrics had previously been sewed together. On the same basis, the Trial Court would have held that there was no new result in *Webster Loom Co. v. Higgins* because the end result was merely carpet.

If the Trial Court was merely concerned with attaching two fabrics together by means of an adhesive without regard to whether the adhesive stiffened the fabric or not, such a process was disclosed in the patents referred to in Finding 6 and was old in the experiments conducted by Neiner as testified to by Ellerbrock at Rec. 545 and 598 and in the "smocking process." However, in those processes and experiments the lining became stiffened by the adhesive, and Ellerbrock rejected the experiments as being unsuccessful for that reason.

It is impossible to determine from Finding 8 (Rec. 33) or the Trial Court's Memorandum Opinion (Rec. 31) whether the Trial Court concerned himself with the new result of retaining softness in both fabrics despite the inherent tendency of the adhesive to stiffen them on drying. This was an essential requirement demanded by the trade. Heretofore, retained softness could only be obtained by hand sewing, but the objection to this was that too much labor was involved. Inasmuch as *Webster Loom Co. v. Higgins* makes the existence of a new result accomplished from a combination of old elements a test of invention, the Trial Court's finding without indicating what result it was considering is inadequate and is not a "special finding" as required by Rule 52A.

The situation presented here is somewhat similar to *Consolidated Safety Valve Co. v. Crosby Steam Gauge & Valve Co.*, 113 U.S. 159, in that the patentee herein is reconciling the inherent tendency of the adhesive to stiffen the fabrics on drying with the demands of the trade that the fabrics remain soft. Therein this Court said:

> "It appears to have been easy enough to make a safety valve which would relieve the boiler; but the problem was to make one which, while it opened with increasing power in the steam against the increasing resistance of a spring, would close suddenly and not gradually by the pressure of the same spring against the steam. *This was a problem of the reconciliation of anatagonisms, which so often recurs in mechanics and without which practically successful results are not obtained.*"

B. Where Others Have Experimented in Endeavoring to Solve a Given Problem and Have Failed, the First Solver of the Problem Is Entitled to a Valid Patent.

This Court in *Expanded Metal Co. v. Bradford,* 214 U.S. 366, 381, said:

> "It may be safely said that if those skilled in the mechanical arts are working in a given field and have failed after repeated efforts to discover a new and useful improvement, that he who first makes the discovery has done more than the obvious improvement which would suggest itself to a mechanic skilled in the art and is entitled to protection as an inventor."

Here the evidence is undisputed as it comes from the defendant's own witnesses, Ellerbrock and Wolf, at Rec. 545, 598 and 651, that Neiner did experiment in endeavoring to solve this identical problem and failed because although he was successful in gluing the fabrics together, he was unable to "produce the softness of the finished product to our satisfaction" (R. 598). There is also the testimony of Z. R. Maulsby (Rec. 200) as to his experiments and failure.

There is no special finding by the Trial Court concerning these experiments and failures but merely the general conclusion embodied in Finding 11 and Paragraph C of the Memorandum Opinion that the patentee's process "does not constitute inventive genius but merely skill by one trained in the art."

In expressing himself in this manner the Trial Court has not only ignored this undisputed evidence in the rec-

ord but has substituted his own personal opinion of what mechanics skilled in this art should have done, for history of what they did not do.

Inasmuch as the rule above announced in *Expanded Metal Co. v. Bradford* is a well recognized and important test of invention the failure of the Trial Court to make a finding on this undisputed evidence renders the findings as a whole totally inadequate.

C. The Process of the Patent in Suit Constituted an Innovation in the Art

In *Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 325 U.S. 327, this Court said:

> "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject matter display 'invention,' 'more ingenuity . . . than the work of a mechanic skilled in the art.' (Citing cases.) This test is often difficult to apply; but its purpose is clear. Under this test, some substantial innovation is necessary, an innovation for which society is truly indebted to the efforts of the patentee."

The evidence in this case shows that after Neiner had made his experiments and had failed that the patentee Maulsby approached Neiner's employer the Kregel Casket Company with his process. Ellerbrock testified (R. 582):

> "We thought Mr. Maulsby had something better is the reason we gave him an opportunity to demonstrate his plan."

Subsequently, the Kregel Casket Company became a licensee (R. 555) and even today the Kregel Casket Company is using the patented process (R. 595, CQ. 233). Ellerbrock regards the patented process as equivalent in quality to hand sewing a lining (R. 616, RDQ. 2).

The patentee approached other casket manufacturers with the process and with a printed license contract reproduced at R. 1089 while his application for a patent was still pending. Between October 28, 1930 and July 30, 1931 twenty-four different manufacturers took licenses of that character. After the patent issued the patentee submitted to the trade licenses of the character reproduced at Rec. 1091, and in a relatively few years the concerns whose names are listed at pages 1092, 1093 and 1094 took licenses of that character. While the license reproduced at 1091 was probably a violation of the Clayton Act, the patentee has since purged himself of this practice and recent licenses reproduced at R. 1095 to 1110 are for valuable considerations and do not conflict with the anti-trust laws.

The very fact that the Casket Manufacturers Association organized a Casket Manufacturers Defense Committee and solicited contributions to the defense (R. 1132 to 1140), appointed counsel and assumed the defense in this case (R. 59) demonstrates that even today the process is of value to casket manufacturers throughout the country who are desirous of securing the legal right to use the process free of charge by invalidating this patent. It is difficult to conceive how proof of "an innovation for which society is truly indebted to the efforts of the patentee" could be established by any more potent evidence than this.

The Trial Court makes no finding whatsoever concerning this evidence but should have done so if the test of patentable invention is whether a substantial innovation in the art has been made as announced in *Sinclair & Carroll Co., Inc. v. Interchemical Corp., supra.*

From the foregoing resume it is believed that the patent in suit meets several well established requirements or rules for the determination of a patentable invention. The Trial Court has made no findings on circumstantial facts which it could and should have done in support of its determination on the question of invention. As the Circuit Court of Appeals has likewise ignored these potent circumstances and affirmed merely because the Trial Court has made a finding on the question of invention, holding that this is a question of fact, and that Rule 52A is applicable a serious injustice is done to the patentee.

In *Sinclair & Carroll Co., Inc. v. Interchemical Corp., supra,* this Court said:

> "There has been a tendency among the lower federal courts in infringement suits to dispose of them where possible on the ground of non-infringement without going into the question of validity of the patent. (Citing cases.) It has come to be recognized, however, that of the two questions, validity has the greater public importance, *Cover v. Schwartz,* 133 F. 2d 541, and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent."

As the District Courts are thus admonished to inquire as to the validity of the patent, it is of equal importance to

instruct the lower courts (1) with relation to what findings should be made by the District Court concerning the question of validity and (2) the manner in which validity of the patent may be reviewed by the Circuit Court of Appeals in order that patentees may be fully protected against unqualified or anti-patent District Judges rendering their valuable grants worthless. Unless some forms of protection is afforded, inventors will refuse to divulge their inventions to the public in exchange for a patent, but instead will retain them as trade secrets. Such procedure could well have been followed by the patentee herein by keeping the process highly secret in his own casket manufacturing plant. This procedure undoubtedly would have been followed if he could have anticipated the treatment by the courts that he has received herein.

The Lack of Adequate Findings by the Trial Court Justifies Granting Certiorari for the Purpose of Remanding to the District Court for the Purpose of Making Adequate Findings.

This Court said in *Schneiderman v. U. S.*, 320 U.S. 118, 129, 130, 131:

> "The pertinent findings of fact on these points, set forth in the margin, *are but the most general conclusions of ultimate fact.* It is impossible to tell from them upon what underlying facts the court relied, and whether proper statutory standards were observed. If it were not rendered unnecessary by the broad view we have taken of this case we would be inclined to

reverse and remand to the District Court for the purpose of making adequate findings.

"The Circuit Court of Appeals affirmed on the ground that the certificate was illegally procured holding that the finding that the petitioner's Oath was false was not 'clearly erroneous,' 119 Fed. 2d 500. We granted certiorari and after having heard argument and re-argument now reverse the judgments below."

The above decision has been interpreted as in effect requiring an epitomizing of all the evidence in the case. See *Brooks Brothers v. Brooks Clothing of California, Ltd.*, 9 Fed. Rules Service 52b.14, Case 1, 5 F.R.D. 14. Whether such detailed findings are required or not, it is believed that the District Court should be required to make adequate findings under Rule 52A so that it is possible to tell from them what underlying circumstantial facts the District Court considered and upon which it relied in arriving at the conclusion of lack of invention. This is of great importance particularly when the Circuit Court of Appeals, as herein, has confined its review to whether or not the conclusion of lack of invention is a question of fact to which Rule 52A is applicable.

Where the Facts of the Prior Art Are Not in Dispute and the Question Is Whether the Improvement Thereover Shall Be Designated a Patentable Invention This Question Becomes a Question of Law and Should Be Treated as Such on Appeal So That Rule 52A Is Not Applicable.

This Court has indicated that the question of invention is a question of law in *Mahn v. Harwood,* 112 U.S. 354, 358. Dissenting judges have cited *Mahn v. Harwood* to this effect in *Goodyear v. Ray-O-Vac,* 321 U.S. 275. On the other hand, this Court has indicated in *Thompson Spot Welding Co. v. Ford Motor Co.,* 265 U.S. 445, 447, that it is a question of fact.

In *U. S. v. Esnault-Pelterie,* 303 U.S. 26, 30, this Court said:

> " . . . Where with all the evidence before the Court it appears that no substantial dispute of fact is presented and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for purposes of explanation or evaluation of prior art or to resolve questions of the application of descriptions to subject matter the *questions of invention and infringement may be determined as questions of law.*"

Considerable confusion in the Circuit Courts of Appeal has consequently arisen which should be settled. For example, see *Lincoln Stores, Inc. v. Nashua Manufacturing Co.,* 157 Fed. 2d 154, 163 (C.C.A.1):

> "Whether the question of invention is one of fact or of law is not too clear on the authorities; this uncertainty is indeed not entirely dispelled by consideration of decisions of the Supreme Court. See the discussion by Judge Woodbury in *Hanovia Chemical Manufacturing Co. v. David Buttrick*, 127 Fed. 2d 888 (C.C.A.1st 1942). . . . Until advised to the contrary by the Supreme Court we shall so regard it."

For additional cases see *Cusano v. Kotler*, 72 U.S.P.Q. 62, 63 (C.C.A.3); *White v. Bruce*, 73 U.S.P.Q. 420, 421, and *Sbicca Del Mac, Inc. v. Milius Shoe Co.*, 145 Fed. 2d 389.

Whether the question of invention is a question of fact or of law in view of the undisputed evidence as to the prior art facts, the Circuit Court of Appeals herein should not have confined its review to a question of whether the question of invention is a question of fact and whether Rule 52A was applicable. On the contrary, it should have made a real review treating the question as a question of law under *U. S. v. Esnault-Pelterie, supra.* As long as the Circuit Court of Appeals disposes of the appeal in the manner in which it has, a premium is placed on the guess work of the District Judge as to whether a given patent is valid. This is well illustrated by the Record herein.

In the course of oral argument, the Trial Judge said (Reporter's Transcript of Testimony and Proceedings on Trial, Vol. II—not printed but nevertheless transmitted to this Court as part of the Record, page 61, lines 21 et seq.):

"The problem the trial court is constantly facing and must recognize is that our reviewing courts are far more exacting than they formerly were. Formerly the reviewing courts particularly in this district were very favorably inclined to sustaining patents. Certainly, since I have been on the bench, the attitude has been absolutely to the contrary and they are simply following the trend of the Supreme Court, and that is why we sometimes wonder in approaching a question and particularly when we refer to citations and authorities whether a patent which had been held good twenty-five years ago, if it were in the reviewing court today, could stand the test, and of course we must be constantly cognizant of *the high degree of inventive genius, if anybody can tell me what that is,* that the reviewing courts are now requiring. . . . But the Supreme Court [Circuit Court of Appeals] in this circuit rarely sustains a patent. They did a while back I know. It was so rare that there was quite a comment when Judge Yankwich was affirmed; but they are so rare that the trial court naturally requires, you might say, a higher degree of so-called inventive genius before it recognizes the patent."

See also page 66:

"I look upon this case as a borderline case. I haven't come to any conclusion one way or the other. From one way I approach it I feel that the patent is invalid. Then I look at it another way and I can see elements there that would justify your position; and from a third way of looking at it I recognize that I have the reviewing courts ahead of me which are very exacting. That is my state of mind in this case."

We thus have a situation wherein the Trial Court regarded the question of invention as "a borderline case" and confesses that he does not know what "the high degree of inventive genius" is that the reviewing courts are now requiring. He is nevertheless called upon to decide the question of invention one way or the other. In this case he has finally decided this "borderline case" adverse to the petitioner probably because of intimidation or fear of reversal if he sustains the patent. If the Circuit Court of Appeals can dispose of the appeal by merely determining that the conclusion that the District Court has made under these circumstances is a question of fact and can only be set aside if "clearly erroneous" the situation quickly develops into a vicious circle which only this Court can break. The Trial Court being constantly observant of the fatality of patents before the Appellate Courts feels safer in invalidating the patent and the Circuit Court of Appeals rubber stamps his judgment. The anti-patent record of the Appellate Courts thus increases and the District Courts become constantly more prone to hold a patent invalid for lack of invention knowing that in so doing the Circuit Court of Appeals will probably affirm. We, therefore, urge this Court to reaffirm the rule announced in *U. S. v. Esnault Pelterie, supra,* and require the Circuit Court of Appeals to make a real review instead of a perfunctory approval.

Even If There Had Been a Conflict of Evidence on the Questions of Novelty or Invention It Was the Duty of the Circuit Court of Appeals Herein to Give Little Weight to the Trial Court's Findings Thereon Because of the Fact That Seven-Eighths of the Record Is by Deposition.

In this case pages 54 to 180 of the printed record are of testimony taken in open court. Pages 185 to 1064 are of testimony by deposition. In other words, seven-eighths of this Record is made up of depositions.

No such weight under Rule 52A should have been given to the Trial Court's finding of lack of invention as has been given to it by the majority herein. The majority herein are inconsistent with other judges of the same Circuit Court of Appeals in *Equitable Life Assurance Society of the United States v. Irelan,* 123 Fed. 2d 462 (C.C.A.9):

> "Since all testimony bearing on the circumstances antecedent to and surrounding her death was by deposition, the finding of accidental death while it is justly entitled to consideration has not the weight we would otherwise be obliged to concede to it. This Court is in as good a position as the Trial Court was to appraise the evidence and we have the burden of doing that. Rule 52A of the Rules of Civil Procedure was intended to accord with the decisions on the scope of the review in federal equity practices; and, as is well known in the federal courts where the testimony in equity or admiralty cases is by deposition the reviewing court gives slight weight to the findings." (Citing many cases in the footnote).

See also *Globe-Union Inc. v. Chicago Telephone Supply Co.* (C.C.A.7), 103 Fed. 2d 722.

Therefore, even had there been a conflict in the evidence on the questions of novelty or invention as asserted by the majority of the Circuit Court of Appeals herein, the majority should nevertheless have reviewed the deposition evidence and made its own resolution of any conflict lurking therein. No such conflict actually exists, with the exception of Hall whose deposition testimony has already been disposed of by the Trial Court in the course of argument as previously noted.

Cases Believed to Sustain the Jurisdiction

This Court will grant certiorari to settle an important question of practice presented under the Rules of Civil Procedure, *Leisham v. Associated Wholesale Electric Co.*, 318 U.S. 203.

Rule Involved

Rule 52 of the Rules of Civil Procedure, Findings, by the Court:

> "(a) Effect. In all actions tried upon the facts without a jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its

action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court.

"(b) Amendment. Upon motion of a party made not later than 10 days after entry of judgment the court may amend its findings or make additional findings and may amend the judgment accordingly. The motion may be made with a motion for a new trial pursuant to Rule 59. When findings of fact are made in actions tried by the court without a jury, the question of the sufficiency of the evidence to support the findings may thereafter be raised whether or not the party raising the question has made in the district court an objection to such findings or has made a motion to amend them or a motion for judgment."

CONCLUSIONS

1. The Trial Court herein has not made adequate findings of fact under Rule 52A to enable it to be determined therefrom upon what underlying facts the Trial Court relied or whether proper standards were observed on the question of patentable invention.

2. The Circuit Court of Appeals herein has erred in confining itself to a mere determination that a finding on a question of invention is a finding fact and Rule 52A is applicable.

3. In view of the undisputed evidence as to the character of the prior art the Circuit Court of Appeals should have reviewed the question of invention as a question of law.

4. In view of the fact that so much of the Record is by deposition, the Circuit Court of Appeals should have given little weight to the finding of the Trial Court on the question of invention, and instead have made a complete review as was done by the dissenting judge.

You are accordingly respectfully petitioned to grant certiorari as the questions of law involved herein are of great importance and should be determined by this Court.

Respectfully submitted,

FRED H. MILLER,
Attorney for Petitioner.